

Appln No.: 09/869,365
Amendment Dated: November 18, 2003
Reply to Office Action of July 18, 2003

REMARKS/ARGUMENTS

This is in response to the Office Action mailed July 18, 2003 for the above-captioned application. Reconsideration and further examination are respectfully requested.

Applicants request an extension of time to make this paper timely, and enclose the fee. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 15-0610.

Claims 24-27 were rejected under 35 USC § 112, second paragraph. Claim 24 has been amended to the same format as claim 20 to provide the proper antecedent basis for "carbon". No new issues are raised, and this amendment should be effective to overcome the rejection. Thus, entry after final rejection is appropriate.

Claims 18-21 and 24-26 stand rejected as anticipated by Hass et al., US Patent No. 4407849. The Examiner references claims 21 and 26 and states that the method of forming a device is not germane to the patentability of a device itself. Applicants respectfully point out that all of the claims include product by process language, i.e., the use of physical vapour deposition or a chemical vapour deposition to apply the coating material. Thus, the Examiner remark should properly apply to all of the claims, since Hass does not disclose such a process.

As a matter of law, the statement that method of making limitations are not germane to patentability is limited to the case where the use of the stated method produces the same product as the method employed in the art. The MPEP § 2113 notes that

the structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product. See, e.g., *In re Garnero*, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979) (holding "interbonded by interfusion" to limit structure of the claimed composite and noting that terms such as "welded," "intermixed," "ground in place," "press fitted," and "etched" are capable of construction as structural limitations.)

Here, the specification states that the method by which the coating material is applied does materially impact the nature of the product, and thus presumably the structure of the applied coating. The Examiner has provided no reasons why this statement is not believable, and indeed the likelihood that chemical or vapour deposition methods would lead to a coating with a physical structure that was the same as the coating formed by some other methods, such as by

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spraying of colloidal graphite, seems small.


In order to support an anticipation rejection, the Examiner must show that the structure of the present claims is met by the reference. In this case, the Examiner has not addressed, why this is a reasonable conclusion when the claims are considered in light of the specification. Furthermore, anticipation cannot be found because a coating like that claimed might result from the method recited in the reference. Rather, the same structure must result as a necessary consequence of practicing the disclosure of the cited reference. *In re Robertson*, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999). Thus, Applicants submit that the Examiner has failed to support a case for the anticipation rejection.

The Examiner has also rejected claims 27-29, 32, and 35-36 as obvious over Hass, and therefore unpatentable under 35 USC § 103. This rejection, like the anticipation rejection is based on the premise that the manner of deposition is irrelevant to the structure and nature of the product. Indeed, the Examiner argues (without the support required by *In re Ahlert*, 165 USPQ 418, 420-21 (CCPA 1970), which support is hereby requested absent a withdrawal of the rejection) that physical vapour deposition, chemical vapour deposition, spraying and printing are art recognized equivalents. If this is true in a general sense, then the fact that the products are not the same is evidence of non-obviousness.

Applicants enclose herewith an unsigned copy of a declaration which demonstrates that the nature of the product does depend on the manner in which the coating material is deposited, and will provide a signed copy of the declaration as soon as it is received from the inventors in Europe. This declaration shows that the premise of the obviousness rejection is in error. For this reason, the rejection should be withdrawn.

For these reasons, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,



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Page 5 of 5